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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/998,895	11/30/2001	Joan C. Teng	OBLX-01033US0	4164
7590	07/20/2006		EXAMINER	
Burt Magen Vierra Magen Marcus Harmon & DeNiro, LLP 685 Market Street, Suite 540 San Francisco, CA 94105-4206				RUTLEDGE, AMELIA L
			ART UNIT	PAPER NUMBER
			2176	

DATE MAILED: 07/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/998,895	TENG ET AL.
	Examiner Amelia Rutledge	Art Unit 2176

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 04 May 2006.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-11,13-21,23-31 and 33-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-11,13-21,23-31 and 33-36 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>5/4/06</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

1. This action is responsive to communications: Amendment, filed 05/04/2006.
2. Claims 1-11, 13-21, 23-31, and 33-36 are pending in the case. Claims 1, 14, and 24 are independent claims. Claims 37 and 38 have been cancelled.

Information Disclosure Statement

3. The information disclosure statement filed 05/04/2006 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because p. 5-7 of the IDS, items C2-C33 cites Office Actions for various patent applications, which are neither patents nor publications, and do not constitute prior art. It has been placed in the application file, but the information referred to therein has not been considered as to the merits.
Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609.05(a).

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. **Claims 1-11, 13-21, 23-31, and 33-36 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

Art Unit: 2176

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6. **In regard to independent claim 1**, claim 1 claims a method for using workflows, comprising a series of steps. Claim 1 is directed to non-statutory ^{Subject matter} for two reasons. First, the claimed invention as a whole must accomplish a practical application. That is, it must produce a “useful, concrete, and tangible result.” *State Street*, 149 F.3d at 1373-74, 47 USPQ2d at 1601-02. (See *Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility*, p. 1 and 51). Claim 1 does not satisfy the practical application requirement because the association of workflows with groups and performing a task is not sufficient to show a practical application. Secondly, claim 1 is not recorded on any computer-readable medium, so that even if the practical application requirement were satisfied, the requisite functionality would still not be present. Note that merely claiming nonfunctional descriptive material, i.e., abstract ideas, stored in a computer, does not make it statutory.

7. **Regarding dependent claims 2-11 and 34-36**, claims 2-11 and 34-36 are rejected because they add nothing to render the claimed subject matter statutory.

8. **In regard to independent claim 14**, claim 14 claims processor readable storage device(s) having processor readable code used to perform the method as claimed in claim 1. While claim 14 is recorded on a computer readable medium, claim 14 does not satisfy the practical application requirement since claim 14 is directed toward a method substantially similar to claim 1.

9. **Regarding dependent claims 15-21 and 23**, claims 15-21 and 23 are rejected because they add nothing to render the claimed subject matter statutory.

10. **In regard to independent claim 24,** claim 24 claims an apparatus that uses workflows, comprising a communication interface and one or more processors in communication with the communication interface. However, claim 24 is not recorded on any computer-readable medium, and therefore may be descriptive material, i.e., software *per se*, and is not statutory because the elements of the apparatus are not capable of causing functional change in the computer, since they may be represented by software alone (See *Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility*, p. 52). Further, claim 24 does not satisfy the practical application requirement since claim 14 is directed toward a method substantially similar to claim 1.

11. **Regarding dependent claims 25-31 and 33,** claims 25-31 and 33 are rejected because they add nothing to render the claimed subject matter statutory.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 1-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Du et al. (hereinafter “Du”), U.S. Patent No. 6,041,306, issued March 2000, in view of SiteMinder Policy Server Operations Guide, Version 4.0 (hereinafter**

"SiteMinder"), Netegrity Inc., published 1997 and submitted with Applicant's Information Disclosure Statement filed March 15, 2004.

Amended independent claim 1 cites: *A method for using workflows, comprising the steps of: associating workflows with one or more groups in an identity system, each group including one or more users of the identity system; receiving a request to perform a task that pertains to at least one identity profile of an entity in said identity system; and performing a first workflow for said task, said first workflow is associated with a first group that includes a target identity profile of said request;*

Du teaches a method for performing flexible workflow process execution in a distributed workflow management system (Abstract), and encapsulating legacy systems using business objects as a representation of something active in the business domain, to map between the business model and the operational procedures of the workflow process system (Col. 8, l. 36-44; l. 52-64). Du teaches launching workflow process instances in response to user requests (Col. 7, l. 45-46). Du teaches that a policy is a set of rules that determines how resources, i.e., users, are related to tasks (Col. 8, l. 52-63). Although Du teaches applying policies to users, Du does not explicitly teach associating workflows with groups in an identity system. However, SiteMinder teaches a policy server, i.e., identity system, for associating workflows, i.e., rules for user interaction with system resources, with policy domains (p. 235-237) by using SiteMinder responses and response groups (Chapter 11, p. 302-304) and creating policies to specify actions that should take place when users access specific resources, which are

tasks and/or software within a domain (Chapter 12, Policies, p. 325-328), compare to *associating workflows with one or more groups in an identity system, each group including one or more users of the identity system.* Specifically, SiteMinder teaches that a policy domain is a logical grouping of resources associated with one or more user directories, i.e., one or more users of the system (p. 235, par. 1; p. 235).

Claim 1 also cites: *wherein; said first workflow comprises a predefined set of steps that perform said tasks to affect the target identity profile, said predefined set of steps comprising a first step and a second step;*
said first step is performed by a first program;
said second step is performed by a second program;
information is passed between said first program and said second program according to a defined set of rules: and
at least one of the first program and the second program is external to the workflow.

Du teaches creating workflow processes by assembling business objects in sequence, i.e., *comprises a predefined set of steps that perform said tasks, and applying a set of rules for passing information between programs, and executing the flexible workflow processes as specified by a directed graph comprising a set of nodes connected by arcs* (Col. 8, l. 45-63; Col. 11, l. 26-Col. 12, l. 29). Du teaches resource mapping in flexible workflow paths that also support redirect resource mapping, which allows a business object to recommend another business object for a task (Col. 17, l. 25-40), compare to *information is passed between said first program and said second*

program according to a defined set of rules: and at least one of the first program and the second program is external to the workflow. The flexible workflow execution allows freedom of task assignment and external activities to be performed (Col. 12, l. 41-43; Col. 6, l. 39-49).

Both Du and SiteMinder are analogous art, since both are directed toward policy and identity management. It would have been obvious to one of ordinary skill in the art at the time of the invention to apply SiteMinder to Du, so that Du would have the benefit of a policy server which would integrate applications and improve workflow by integrating directories and external databases in its policies so that legacy applications and systems could still be used (SiteMinder, p. 22-23, last paragraph).

Regarding dependent claim 2, while Du does not explicitly teach associating a workflow with a hierarchical data structure, SiteMinder teaches creating a policy domain which contains zero or more realms (p. 241, "Creating a Realm"). SiteMinder teaches that realms represent groups of resources and realms can be nested within other realms to represent the grouping of network resources (p. 247-249, "Understanding Nested Realms"). Both Du and SiteMinder are analogous art, since both are directed toward policy management. It would have been obvious to one of ordinary skill in the art at the time of the invention to apply SiteMinder to Du, so that Du would have the benefit of a policy server which would integrate applications and improve workflow by integrating directories and external databases in its policies so that legacy applications and systems could still be used (SiteMinder, p. 22-23, last paragraph).

Regarding dependent claim 3, Du teaches identifying one or more workflows associated with a target identity profile (Col. 5, l. 59-Col. 6, l. 10). SiteMinder teaches associating resources with a policy domain (p. 235-236). Both Du and SiteMinder are analogous art, since both are directed toward policy management. It would have been obvious to one of ordinary skill in the art at the time of the invention to apply SiteMinder to Du, so that Du would have the benefit of a policy server which would integrate applications and improve workflow by integrating directories and external databases in its policies so that legacy applications and systems could still be used (SiteMinder, p. 22-23, last paragraph).

Regarding dependent claim 4, Du teaches that in flexible workflow process execution multiple workflows can be created and/or adapted to a user request, and that a user can identify a target identity profile of another user, thereby altering the workflow and a new workflow or set of workflows may be created to perform the task (Col. 19, l. 54-67).

Regarding dependent claims 5 and 6, Du teaches that the user can request to delete or modify a target identity profile, for example the role specification and activity to a business object (Col. 19, l. 54-67). In another example, the user can request to add or drop communication paths between certain endpoints in a private virtual network (Col. 10, l. 40-45).

Regarding dependent claims 7 and 8, Du teaches the steps of identifying a set of one more workflows that perform a task and are associated with domains that include the target, and reporting one more workflow, and receiving from a user a selection of

the first workflow, and performing one or more steps of said first workflow, in the prototype of automatically configuring a data path with a flexible workflow (Fig. 6, Col. 10, l. 5-Col. 11, l. 25). SiteMinder teaches a policy server, i.e., identity system, for associating workflows, i.e., rules for user interaction with system resources, with policy domains (p. 235-237) by using SiteMinder responses and response groups (Chapter 11, p. 302-304) and creating policies to specify actions that should take place when users access specific resources, which are tasks and/or software within a domain (Chapter 12, Policies, p. 325-328). Both Du and SiteMinder are analogous art, since both are directed toward policy and identity management. It would have been obvious to one of ordinary skill in the art at the time of the invention to apply SiteMinder to Du, so that Du would have the benefit of a policy server which would integrate applications and improve workflow by integrating directories and external databases in its policies so that legacy applications and systems could still be used (SiteMinder, p. 22-23, last paragraph).

Regarding dependent claims 9 and 10, Du teaches the use of policies to ensure proper authorization and authentication (Col. 8, l. 57-63), but Du does not explicitly teach an integrated identity and access system. However, SiteMinder comprises an integrated identity and access system (p. 20-24, "Overview") with user self-registration (p. 395, par. 2). Both Du and SiteMinder are analogous art, since both are directed toward policy management. It would have been obvious to one of ordinary skill in the art at the time of the invention to apply SiteMinder to Du, so that Du would have the benefit of a policy server which would integrate applications and improve

workflow by integrating directories and external databases in its policies so that legacy applications and systems could still be used (SiteMinder, p. 22-23, last paragraph).

Regarding dependent claim 11, Du teaches that workflows can delegate work to other workflow processes or resources (Col. 20, l. 50-Col. 21, l. 15).

Regarding dependent claim 13, while Du does not explicitly teach associating a workflow with a hierarchical data structure, SiteMinder teaches creating a policy domain which contains zero or more realms (p. 241, "Creating a Realm"). SiteMinder teaches that realms represent groups of resources and realms can be nested within other realms to represent the grouping of network resources (p. 247-249, "Understanding Nested Realms"). SiteMinder teaches that the hierarchical data structure of policy domains and realms includes an LDAP directory (p. 352). Both Du and SiteMinder are analogous art, since both are directed toward policy management. It would have been obvious to one of ordinary skill in the art at the time of the invention to apply SiteMinder to Du, so that Du would have the benefit of a policy server which would integrate applications and improve workflow by integrating directories and external databases in its policies so that legacy applications and systems could still be used (SiteMinder, p. 22-23, last paragraph).

In regard to independent claim 14, claim 14 reflects the processor readable storage device(s) having processor readable code used to perform the method as claimed in claim 1, and is rejected along the same rationale.

In regard to dependent claims 15-21 and 23, claims 15-21 and 23 reflect the processor readable storage device(s) having processor readable code used to perform

the method as claimed in claims 2, 3, 4, 7-9, 11, and 13, and are rejected along the same rationale.

In regard to independent claim 24, claim 24 reflects the apparatus used to perform the method as claimed in claim 1, and is rejected along the same rationale.

In regard to dependent claims 25-33, claims 25-31 and 33 reflect the apparatus used to perform the method as claimed in claims 2, 3, 4, 7-9, 11, and 13, and are rejected along the same rationale.

Regarding dependent claims 34 and 35, while Du teaches a flexible workflow process execution system, Du does not explicitly teach managing a target identity profile. However, SiteMinder teaches automatically managing target user identity profiles using workflows, i.e., specifying templates and sequences for registration (p. 398-399; p. 398-401). SiteMinder teaches applying domain policies to users (p. 141-416), i.e., changing a user attribute. Both Du and SiteMinder are analogous art, since both are directed toward policy management. It would have been obvious to one of ordinary skill in the art at the time of the invention to apply SiteMinder to Du, so that Du would have the benefit of a policy server which would integrate applications and improve workflow by integrating directories and external databases in its policies so that legacy applications and systems could still be used (SiteMinder, p. 22-23, last paragraph).

Regarding dependent claim 36, while Du does not explicitly teach managing certificates, SiteMinder teaches managing certificates associated with identity profiles

(p. 533-536) via the user's browser. Both Du and SiteMinder are analogous art, since both are directed toward policy management. It would have been obvious to one of ordinary skill in the art at the time of the invention to apply SiteMinder to Du, so that Du would have the benefit of a policy server which would integrate applications and improve workflow by integrating directories and external databases in its policies so that legacy applications and systems could still be used (SiteMinder, p. 22-23, last paragraph).

Response to Arguments

Applicant's arguments filed 05/04/2006 have been fully considered but they are not persuasive. Applicant argues that the Du and SiteMinder references do not teach the newly claimed limitations *associating workflows with one or more groups in an identity system, each group including one or more users of the identity system; receiving a request to perform a task that pertains to at least one identity profile of an entity in said identity system; and performing a first workflow for said task, said first workflow is associated with a first group that includes a target identity profile of said request;* (Claim 1). However, SiteMinder teaches a policy server, i.e., identity system, for associating workflows, i.e., rules for user interaction with system resources, with policy domains (p. 235-237) by using SiteMinder responses and response groups (Chapter 11, p. 302-304) and creating policies to specify actions that should take place when users access specific resources, which are tasks and/or software within a domain (Chapter 12, Policies, p. 325-328). Specifically, SiteMinder teaches that a policy

Art Unit: 2176

domain is a logical grouping of resources associated with one or more user directories, i.e., one or more users of the system (p. 235, par. 1; p. 235).

3. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, both Du and SiteMinder are analogous art, since both are directed toward policy management. It would have been obvious to one of ordinary skill in the art at the time of the invention to apply SiteMinder to Du, so that Du would have the benefit of a policy server which would integrate applications and improve workflow by integrating directories and external databases in its policies so that legacy applications and systems could still be used (SiteMinder, p. 22-23, last paragraph).

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amelia Rutledge whose telephone number is 571-272-7508. The examiner can normally be reached on Monday - Friday 9:30 - 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on 571-272-4136. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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